

REMARKS

The application has been reviewed in light of the final Office Action dated January 6, 2005. Claims 1-23 are pending, with claims 11-23 having been withdrawn by the Patent Office from consideration. By this Amendment, claims 1 and 6 have been amended to place the claims in better form for reconsideration, without narrowing the scope of the subject matter claimed as the invention. Accordingly, claims 1-10 are presented for reconsideration, with claims 1 and 6 being in independent form.

Claims 1-10 were rejected under 35 U.S.C. §112, second paragraph as allegedly indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

This application relates to transactions conducted electronically between a user-side and a supplier-side, that is, the consumer is not physically present at the supplier's point of sale. Fig. 1 of this application shows an exemplary electronic transaction system wherein a consumer through a terminal connected to a computer (or other telecommunication) network engages in electronic communication with a supplier through a supplier server computer. Transaction information is in electronic form in such a system. In a conventional electronic transaction system, the supplier or the consumer must take action to specify and/or request that transaction information be printed. Applicant devised a technique by which the transaction information to be printed is automatically identified and printed, each without user (or supplier) action.

By this Amendment, claims 1 and 6 have been amended to place the claims

in better form for reconsideration and clarify that the claimed invention is directed to an electronic transaction including electronic communication between a user-side and a supplier-side. Applicant submits that the claims as amended clearly identify the subject matter Applicant deems to be the claimed invention of this application.

Accordingly, withdrawal of the rejection under 35 U.S.C. §112, second paragraph is requested.

Claims 1-10 were rejected under 35 U.S.C. §102(b) as purportedly anticipated by U.S. Patent No. 5,892,824 to Beatson et al. Claims 1-10 were rejected under 35 U.S.C. §102(b) as purportedly anticipated by U.S. Patent No. 5,590,197 to Chen et al. Claims 1-10 were rejected under 35 U.S.C. §102(e) as purportedly anticipated by U.S. Patent No. 6,115,690 to Wong. Claims 1-10 were rejected under 35 U.S.C. §103(a) as allegedly unpatentable over Beatson. Claims 1-10 were rejected under 35 U.S.C. §103(a) as allegedly unpatentable over Wong.

Applicant has carefully considered the Examiner's comments and the cited art, and respectfully submits that independent claims 1 and 6 are patentable over the cited art, for at least the following reasons.

The claimed invention of this application provides for automatically identifying, without reliance on user action, a selected aspect of information regarding the electronic transaction (for example, but not limited to, a confirmation number, password, invoice information, etc.) in an electronic communication between the user-side and the supplier-side, and after automatically identifying the selected aspect of information generating a print request.

The cited art does not disclose or suggest the claimed invention.

Beatson, as understood by Applicant, is directed to electronic signature capture and verification in a point-of-sales system, wherein a store clerk specifies a command to a point-of-sale terminal to print out a paper receipt, and places the printed receipt on a signature device (i.e. tablet) for the customer to sign. As the customer signs the printed receipt (over the signature device), the signature device captures an electronic image of the customer's handwritten signature and stores it in memory.

The point-of-sales system of Beatson, although electronic, is not, however, a system for conducting a transaction electronically between a user-side and a supplier-side, that is, the consumer must be physically present at the supplier's point of sale, in order to sign the printed receipt. As with conventional in-store credit (or debit or smart) card transactions, the transaction is not completed until after the receipt is signed by the consumer.

In addition, Beatson also fails to disclose or suggest automatically identifying, without reliance on user action, a selected aspect of information regarding the electronic transaction in an electronic communication between the user-side and the supplier-side, and after automatically identifying the selected aspect of information generating a print request, as provided by the claimed invention of independent claims 1 and 6 as amended.

It is contended in the Office Action that Beatson discloses various features of the claimed invention. However, the Office Action does not cite, by reference to column and line (or other) numbers, support in the Beatson for the contention.

Moreover, as the Office Action acknowledged, the communication between user-side and supplier side is verbal (or oral), and not electronic as in the claimed invention.

Chen, as understood by Applicant, is directed to an electronic payment system. Chen discloses that protected account information can be carried or stored securely in a “cyber wallet”, and the information is accessed in order to carry out transactions requiring electronic payment over an open communications network.

Applicant do not find teaching or suggestion in Chen, however, of a method for automatically printing, without a need for user action, a hard copy of transaction information relating to a transaction conducted electronically between a user-side and a supplier-side, as provided by the claimed invention of independent claims 1 and 6. Indeed, Applicant does not find mention of printing at all in Chen.

It is contended in the Office Action that Chen anticipates the claimed invention. However, the Office Action does not cite where in Chen one can find teaching or suggestion of the various features of the claimed invention. As the Federal Circuit as repeatedly admonished, a prior art rejection must be supported by substantial evidence and cannot stand on flat assertions and contentions without factual support.

Wong, as understood by Applicant, is directed to a business-to-business web commerce system based on a single integrated database management system.

Applicant do not find teaching or suggestion in Wong, however, of a method for automatically printing, without a need for user action, a hard copy of

transaction information relating to a transaction conducted electronically between a user-side and a supplier-side, as provided by the claimed invention of independent claims 1 and 6.

While Wong discloses various features for automated business-to-business web commerce transactions, Wong discloses that a clerk prints out the invoice to be sent to the business customer. In addition, although the clerk can specify through a user interface that invoices can be sent after 30 (or 60, 90, etc.) days, Applicant does not find teaching or suggestion in Wong of automatically identifying, without reliance on user action, a selected aspect of information regarding the electronic transaction in an electronic communication between the user-side and the supplier-side, and after automatically identifying the selected aspect of information generating a print request, as provided by the claimed invention of amended claims 1 and 6.

Further, it is noted that while the Wong reference is more than 400 pages in total, the Office Action fails to identify where in Wong one can find teaching or suggestion of the various features of the claimed invention.

Accordingly, for at least the above-stated reasons, Applicant respectfully submits that independent claims 1 and 6, and the claims depending therefrom, are patentable over the cited art.

If the Examiner should disagree, Applicant requests that the Examiner cite by column and line number where in the cited reference one can find basis for the disagreement.

If a petition for an extension of time is required to make this response

timely, this paper should be considered to be such a petition. The Office is hereby authorized to charge any fees that may be required in connection with this amendment and to credit any overpayment to our Deposit Account No. 03-3125.

If a telephone interview could advance the prosecution of this application, the Examiner is respectfully requested to call the undersigned attorney.

Allowance of this application is respectfully requested.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Paul Teng", is written over a horizontal line.

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